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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
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ART UNIT	PAPER NUMBER
2121	

DATE MAILED: 10/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/828,904	CONTRACTOR, SUNIL H.
	Examiner	Art Unit	
	Thomas K. Pham	2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>26 July 2006</u>.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,7-16,18-24,26,27,29-35,37-41,43-45,48,49,51 and 53-55* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *1-5,7-9,18-24,26,27,29-35,37-39,45,48 and 49* is/are allowed.

6)☒ Claim(s) *10-17, 40-44, 51 and 53-55* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

Response to Amendment

1.   This action is in response to the amendment filed on 07/26/2006.

2.   Claims 1-5, 7-9, 18-24, 26, 27, 29-35, 37-39, 45, 48 and 49 are allowed.

3.   Applicant's arguments, with respect to claims 10-17, 40-44, 51 and 53-55, have been

considered but they are not persuasive.

Quotations of U.S. Code Title 35

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim Rejections - 35 USC § 103

6.   Claims 10-17, 40-44, 51 and 53-55 are rejected under 35 U.S.C. 103(a) as being

unpatentable over U.S. Patent No. 5,870,724 ("Lawlor") in view of U.S. Patent Application

Publication No. 2004/0236650 ("Zapiec").

Regarding claim 10

Lawlor teaches a method of identifying users to a caller, comprising:

-   transmitting a user information record to a caller to cause the caller to place a call to the

    user after the online session has ended (col. 31 lines 53-59, "... user information is to

    pass it to the advertiser ... as soon as the user disconnects his terminal ...").

Lawlor does not specifically disclose whether the end of an online session of a user is detected;

and storing a record of the online session that indicates that the online session of the user has

recently ended, wherein the record includes the time the online session ended.

However, Zapiec discloses a software means for collecting and electronically

transmitting FTP file in real-time information regarding an Internet online session of a user such

as from the time the user logs on to the online session to the time the user logs off online session

(see paragraph 41); and storing a record of the online session that indicates activities of the users

including when the user has just logged off the online Internet sessions (see paragraphs 14 and

66) , wherein the record includes the time the online session ended (see paragraph 55) for the

purpose of recording all Internet activity and corresponding usage times (see paragraph 13).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention to incorporate the software means of Zapiec with the system of Lawlor because it

would provide Lawlor with an additional benefit of recording and transmitting in real-time to the

advertiser information regarding online activities and the corresponding usage times of a particular user including at least when the user logs off the online sessions.

Regarding claim 40

Lawlor teaches a system for dentifying users to a caller, comprising:

- means for storing record comprises a database storing a phone number of the user (see col. 31 lines 48-52, "... central computer 52 may the provide limited user information (e.g. name and telephone number)...);

- means for and transmitting the record to a caller to cause the caller to place a call to the user after the online session has ended (col. 31 lines 53-59, "... user information is to pass it to the advertiser ... as soon as the user disconnects his terminal ...").

Lawlor does not specifically disclose whether the end of an online session of a user is detected; and storing a record of the online session that indicates that the online session of the user has recently ended, wherein the means for storing a record comprises a database storing the time of the end of the online session.

However, Zapiec discloses a software means for collecting and electronically transmitting FTP file in real-time information regarding an Internet online session of a user such as from the time the user logs on to the online session to the time the user logs off the online session (see paragraph 41); and storing a record of the online session that indicates activities of the users including when the user has just logged off the online Internet sessions (see paragraphs 14 and 66), wherein the means for storing a record comprises a database storing the time of the end of the online session (see paragraph 55) for the purpose of recording all Internet activity and corresponding usage times (see paragraph 13).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the software means of Zapiec with the system of Lawlor because it would provide Lawlor with an additional benefit of recording and transmitting in real-time to the advertiser information regarding online activities and the corresponding usage times of a particular user including at least when the user logs off the online sessions.

Regarding claim 51

Lawlor teaches a system for identifying users to call, comprising:

- an output module for sending the online session data to a third party caller to cause the third party to place a call to the user after the online session of the user has ended(col. 31 lines 53-59, "... user information is to pass it to the advertiser ... as soon as the user disconnects his terminal ...").

Lawlor does not specifically disclose whether a remote access server for determining when an online session of a user has ended; and a memory for storing online session data including data sufficient to identify the time the online session of a user ended.

However, Zapiec discloses a remote access server (see paragraph 37) with a software means for collecting and electronically transmitting FTP file in real-time information regarding an Internet online session of a user such as from the time the user logs on to the online session to the time the user logs off the online session (see paragraph 41); and a memory for storing a record of the online session that indicates activities of the users including when the user has just logged off the online Internet sessions (see paragraphs 14 and 66) for the purpose of recording all Internet activity and corresponding usage times (see paragraph 13).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention to incorporate the software means of Zapiec with the system of Lawlor because it

would provide Lawlor with an additional benefit of recording and transmitting in real-time to the

advertiser information regarding online activities and the corresponding usage times of a

particular user including at least when the user logs off the online sessions

Regarding claims 15, 38 and 53

Lawlor teaches the online session data includes a phone number (col. 3 lines 51).

Regarding claims 16 and 55

Lawlor teaches the online session data includes a phone number and an address (col. 32 lines 5-

12).

Regarding claims 17 and 36

Zapiec teaches a determination of the time and the time interval since an Internet session was

completed (see paragraph 66).

Regarding claims 11, 12 and 44

Lawlor teaches a third party other than the ISP and other than the user receives the session data

(col. 31 lines 48-52); the third party is a telemarketer (col. 31 line 54).

Regarding claim 13

Lawlor teaches transmitting is performed in substantially real time relative to the step of storing

(col. 31 lines 52-55).

Regarding claim 14

Lawlor teaches the transmitting is performed in real-time (col. 31 lines 52-55, it should be noted that real-time must be within fifteen minutes).

Regarding claim 42

Lawlor teaches the online session data includes a phone number and the end time of an online session (col. 31 lines 48-57).

Regarding claim 43

Zapiec teaches transmitting the online session data in form of a FTP file (see paragraph 41).

Regarding claim 41

Lawlor teaches detecting comprises a remote access server (col. 31 lines 52-59).

Regarding claim 54

Lawlor teaches the online session data includes a name (col. 31 line 51).

Response to Arguments

In the remark the applicant argues that cited reference fails to disclose:

I) "storing a record including the time an online session has ended" as to claims 10, 40 and 51.

In response to applicant's argument,

I)   Prior art Zapiec (US Patent Application Publication No. 2004/0236650) discloses a

software means for recording and storing for specific users all information regarding online

Internet sessions activity in "real-time" from the time the users log on to the Internet to the time

the users log off the online sessions. The information is then transmit electronically with in a

FTP file to a remote cite for usage such as billing and/or tracking the user's time spent on an

Internet session as described in paragraphs 36, 40, 41 and/or 55 as follow:

> [0036] If in using the system 100, the user 103 via PC 101 searches the Internet for
> information for a client matter, the sites visited and time spent on Internet are recorded by
> the system 100 and stored on the hard drive of PC 101 or on another on-site or off-site
> storage site such as a remotely located network server (not shown). The information
> regarding the Internet usage may be stored as an Internet access history ledger that may be
> subsequently accessed to generate a listing of the time spent surfing the Internet for the
> client matter. The user 103, e.g., a lawyer or law firm can then generate an invoice for the
> time spent on the Internet and send that bill to the client.

> [0040] It is to be noted that the usage time may be collected over one Internet session, or
> alternatively, may be accumulated over a plurality of Internet sessions and subsequently
> processed. The process of billing for the actual use of the service may occur automatically
> and transparently to the user 103 who is using the system, so that payments are in fact made
> automatically to the time tracking service provider 115. In an alternate embodiment, the
> data files are sent to the tracking service provider 115 automatically, and in return, the user
> 103 or other professional receives an invoice in the mail and pays it using traditional
> methods.

[0041] In one embodiment, a software means in accordance with the principles of the present invention resides on the user's PC 101 that automatically transmits the Internet access history of the Internet usage using an Internet File Transfer Protocol (FTP). <u>This may occur in real-time while the user accesses the Internet.</u> Alternatively, the transmission of the Internet access history ledger to the service provider may occur on a daily/weekly/monthly basis during off-peak hours. Preferably, the Internet usage data is <u>collected for one Internet session</u> (i.e., <u>from the time the user logs on to the time when the user logs out</u>).

[0055] FIG. 5A represents an exemplary report by client matter number. The exemplary report 501 comprises date log 503, user information 505, <u>time in 507, time out 509</u>, site 511 (URL or index of the sites visited), and <u>the actual time spent 513 for a particular date range</u>. As shown in FIG. 5A, the client matter numbers are indicated at the top. Because this system operates across the network, the surfing times may overlap, and a plurality of users simultaneously accessing the Internet may be recorded and reported. FIG. 5A an overlap between different users termed CFN, JDB, and DWF.

Paragraph 55 and FIG. 5A described an example of a <u>report</u> that can be extract from a stored record including the date, the user, the time in and out, the site(s) visited and the actual time spent for a particular date range of the particular user. Furthermore, Zapiec clearly stated that an on-line or Internet session begins when the user logs on to the Internet, and ends when the user logs out of the Internet as described above in paragraph 41 or below in part of paragraph 66:

"... the data may be collected and transmitted for each Internet session (i.e., <u>each time the user logs on to the Internet and searches on the Internet, the session ends when the user logs out</u>). ..."

Furthermore, it should be noted that because the applicant claimed invention includes the term "comprising" which means that the named elements are essential, other elements may be added and still form a construct within the scope of the claim, see Genentech, Inc. v. Chiron Corp., 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997). The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited

elements or method steps. See; e.g., > Mars Inc. v. H.J. Heinz Co., 377 F.3d 1369, 1376,

71 USPQ2d 1837, 1843 (Fed. Cir. 2004) ("like the term comprising,' the terms

containing' and mixture' are open-ended.").< Invitrogen Corp. v. Biocrest Mfg., L.P., 327

F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) ("The transition comprising' in

a method claim indicates that the claim is open-ended and allows for additional steps."). In

this case, even though Zapiec teaches the added features of recording the time spent on each web

sites, Zapiec still within the scope of the claim set for that "the time the on-line session ended" is

known based the time out of the last accessed Web site of the day.

Thus, for at least these reasons, Zapiec teaches the applicant's claimed limitations

specifically for "storing a record including the time an online session has ended".

Conclusion

7.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to examiner *Thomas Pham*; whose telephone number is (571) 272-

3689, Monday - Thursday from 6:30 AM - 5:00 PM EST or contact Supervisor *Mr. Anthony*

Knight at (571) 272-3687.

Any response to this office action should be mailed to: **Commissioner for Patents, P.O.**

Box 1450, Alexandria VA 22313-1450. Responses may also be faxed to the **official fax**

number (571) 273-8300.

Thomas Pham
Patent Examiner

October 19, 2006